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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/618,598  | 07/15/2003  | Koji Kimura          | 03500.017433.       | 6860             |
| 5514  | 7590        | 06/28/2005           | EXAMINER            |                  |
| FITZPATRICK CELLA HARPER & SCINTO<br>30 ROCKEFELLER PLAZA<br>NEW YORK, NY 10112 |             |                      | LE, UYEN CHAU N     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2876                |                  |

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/618,598

Applicant(s)

KIMURA ET AL.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-38 is/are allowed.
- 6) ☒ Claim(s) 39-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Prelim. Amdt/Amendment***

1. Receipt is acknowledged of the Amendment filed 07 April 2005.

### ***Claim Objections***

2. Claim 39 is objected to because of the following informalities:

Re claim 39, line 1: Substitutes "capable of" with -- configured --.

Re claim 39, line 4: Substitutes "power" with -- said power --.

Re claim 39, line 6: Substitutes "the case" with -- case --.

Re claim 39, line 9: Substitutes "the case" with -- case --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nabetani et al (US 5,889,649) in view of Obata et al (US 5,721,717).

Re claims 39-41: Nabetani et al discloses a mechanism which is configured accommodating a card 3 and an adapter 2, comprising: a mounting means for mounting the storage medium/card 3 at the storage medium adapter 2 in case where the card 3 is inserted in the inserting portion (figs. 7-8; col. 7, lines 24-65), and for mounting the adapter in the mechanism in case the adapter is inserted in the inserting portion (figs. 5-6; col. 7, lines 5-23); mounting means has a function of ejecting the card 2 from the adapter 3 and a function of ejecting the adapter 3 from the mechanism (figs. 4-9; col. 5, line 62 through col. 7, line 65).

Nabetani et al is silent with respect to the mounting means is an automatic mounting means for receiving power from a driving means, and means for detecting either the card or the adapter is to be mounted.

Obata et al discloses a mechanism which is configured accommodating a card (i.e., CD 14) and an adapter (i.e., CD carrier 16), comprising: driving means for providing power (i.e., motor control 338); automatic mounting means (i.e., loading motor 112) for receiving power from the driving means/motor control 338; wherein, the automatic mounting means/loading motor 112 automatically mounts/loads the

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adapter/carrier 16 is in the mechanism; an ejecting motor 126 for ejecting the adapter/carrier 16 from the mechanism; a decision means for deciding whether the MO cartridge 12 or the adaptor/CD carrier 16 has been inserted (figs. 1, 26A, 26B & 39; col. 18, line 59 through col. 19, line 40 and col. 26, lines 26-56).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the loading/ejecting motor/driving system of Obata et al into the system as taught by Nabetani et al in order to provide Nabetani et al with an advanced system in which the card is automatically loaded/ejected into/from the reading mechanism, thus providing a time consumption system. Furthermore, providing an automatic or mechanical means to replace a manual activity, which accomplished the same result (i.e., to load/eject a card into/from a card adapter/reader) is not sufficient to distinguish over the prior art.

### ***Response to Arguments***

6. Applicant's arguments with respect to claim 39 have been considered but are moot in view of the new ground(s) of rejection.

7. In response to the Applicant's argument to "Nabetani, however, does not disclose the claimed automatic mounting means for receiving power from the driving means, wherein, in the case where the card is inserted the automatic mounting means automatically mounts the card at the adapter, and, in the case where said adapter is inserted automatic mounting means automatically mounts the adapter in the mechanism, as recited in Claim 39 ... The Nabetani reference does not disclose

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receiving power from the driving means, nor the selective mounting of either the card or adapter." (p. 14, second paragraph), the examiner partially agrees and respectfully submits that providing an automatic or mechanical means to replace a manual activity, which accomplished the same result (i.e., to load/eject a card into/from a card adapter/reader) is not sufficient to distinguish over the prior art. The examiner respectfully requests the Applicant to further review the newly cited references to Obata et al, which has been used in the new ground rejection to further meet the newly added limitation above of the claimed invention, wherein Obata et al discloses a driving means for providing power (i.e., motor control 338); automatic mounting means (i.e., loading motor 112) for receiving power from the driving means/motor control 338; wherein, the automatic mounting means/loading motor 112 automatically mounts/loads the adapter/carrier 16 in the mechanism; an ejecting motor 126 for ejecting the adapter/carrier 16 from the mechanism (figs. 1, 26A & 26B; col. 18, line 59 through col. 19, line 40). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Nabetani in view of Obata et al meets the claimed invention (see the rejection above).

***Allowable Subject Matter***

8. Claims 19-38 are allowed.
9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records to Nabetani et al, Renner et al, Suzuki, Obata et al and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure or the method of an information processing apparatus having an receiving portion for inserting a card and an adapter comprising, among other things, a control member which controls the first driving force transmission member and the second driving force transmission member to eject either of the card or the adapter from the inserting portion, in accordance with the selection by the selecting member, wherein the control member controls the first driving power transmission member so that the adapter is restrained from moving in the ejecting direction of the inserting portion, when ejecting the card from the inserting portion as set forth in the claims combination.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Futter (US 3638233 A); Inaba et al (US 4539670 A); Hashimoto et al (US 6510026 B2); Sugimoto (US 5986891 A); Niwata et al (US 6332578 B1); Kurihashi et al (US 6457647 B1) and Noro et al (US 6634562 B1) are cited as of interest and illustrate to a similar structure of a storage medium mounting/dismounting mechanism and information processing apparatus.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon-Fri. 5:30AM-2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*Uyen-Chau N. Le*

June 24, 2005